Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HERBERT ECK, HEINRICH HOPF, GERALD FLEISCHMANN, ERNST INNERTSBERGER and JAKOB SCHMIDLKOFER

Appeal No. 95-0481
Application 07/842,022[1]

ON BRIEF

Before THOMAS, HAIRSTON and CARDILLO, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellants have appealed to the Board from the examiner's rejection of claims 1 to 8 and 11 to 14. Appellants have cancelled claims 9 and 10 and the examiner has indicated the allowability of claims 15 to 20.

[1] Application for patent filed February 26, 1992.

Representative claim 1 is reproduced below:

1. A process for preparing microencapsulated flakes or powders which comprises drying an aqueous mixture containing (a) at least one water-emulsifiable, non-thermoplastic compound which has a boiling point higher than water and (b) at least one water-soluble, film-forming polymer, in which the amount of component (a) is a maximum of 95% by weight, based on the dry weight of components (a) and (b), with the proviso that the water-soluble, film-forming polymer has a flocculation point of from 20 to 98°C or the flocculation point is adjusted to from 20 to 90°C with the addition of additives, in a thin-layer at a temperature above the flocculation point of the film-forming polymer.

The following reference is relied on by the examiner:

Cabasso et al. (Cabasso) 4,954,381 Sep. 4, 1990

Claims 2 and 3 stand rejected under 35 USC § 112, second paragraph, as being indefinite. Claims 1 to 8 and 11 to 14 stand rejected under 35 USC § 102(b) as anticipated by or, in the alternative, under 35 USC § 103 as being obvious over Cabasso.

Rather than repeat the positions of the appellants and the examiner, reference is made to the Brief and the Answer for the respective details thereof.

OPINION

Turning first to the rejection of claims 2 and 3 under the second paragraph of 35 USC § 112, it is noted that to comply with the requirements of the cited paragraph, a claim must set out and circumscribe a particular area with a reasonable degree of precision and particularity when read in light of the disclosure and the teachings of the prior art as it would be by the artisan. Note In re Johnson, 558 F.2d 1008, 1016, 194 USPQ 187, 194 (CCPA 1977); In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

Although we agree with the examiner that the recitation in dependent claims 2 and 3 of the words "thin-film" does not have an explicit antecedent basis in independent claim 1, which recites the formation of a "thin-layer" at the end of this claim, we cannot agree with the examiner that the recitation in dependent claims 2 and 3 is fatally defective within the second paragraph of 35 USC § 112. From the artisan's perspective, viewing the claimed invention in light of the disclosed invention and the prior art, we conclude that the artisan would not find that the recitation of "thin-film" in dependent claims 2 and 3 would have been indefinite or otherwise ambiguous. Therefore, we reverse the rejection of claims 2 and 3 under the second paragraph of 35 USC § 112. We further note in passing

appellants' willingness at the bottom of page 2 of the Brief to conform the language of dependent claims 2 and 3 to the language in claim 1.

For all the reasons expressed by the examiner in the Answer, and for the additional reasons presented here, we will sustain both prior art rejections of claims 1 to 8 and 11 to 14 under 35 USC §§ 102 and 103.

Initially, we observe that the Brief does not traverse the statement of the rejection of representative claim 1 on appeal that the examiner has made of this claim in the paragraph bridging pages 3 and 4 of the examiner's Answer. The examiner's approach details every limitation of claim 1 to corresponding teachings in the disclosure of Cabasso.

Appellants also do not challenge the examiner's reliance upon the teaching in Cabasso of the use of the optional coagulation feature in this reference correlated to the "flocculation" limitation at the end of claim 1 on appeal.

As to the water-emulsifiable limitation relating to the first cited element of the mixture claimed, we note that the "dispersion" in Cabasso is taught at column 2, lines 46 to 57 to be similar to an emulsion. Note also the discussion beginning at column 6, line 11.

We cannot agree with appellants' overall position that the artisan would not have been placed in possession of the claimed invention in light of Cabasso's teachings. In re Graves, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995), confirms the long standing interpretation that the teachings of a reference may be taken in combination with knowledge of the skilled artisan to put the artisan in possession of the claimed invention even though the patent does not specifically disclose certain features. Graves confirms the principles outlined in In re Le Grice, 301 F.2d 929, 936, 133 USPQ 365, 372 (CCPA 1962) and In re Donohue, 766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985), both of which have been cited by appellants at page 4 of the Brief. Additionally, we note that artisans must be presumed to know something about the prior art relied upon apart from what the reference discloses. In re Jacoby, 309 F.2d 513, 516, 135 USPQ 317, 319 (CCPA 1962). Every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. In re Bode, 550 F.2d 656, 660, 193 USPQ 12, 16 (CCPA 1977).

It goes without saying that it is the teachings of a reference that the examiner relies upon in rejecting the present claims on appeal. The claims in an issued patent are not used as the measure of the teaching value of the reference for purposes of applying it as prior knowledge or prior art to pending claims

on appeal. It is clear to us that appellants' arguments directed at representative independent claim 1 on appeal are more specific than the actual recitation of the limitations in that claim per se and that appellants' arguments based on the claims in Cabasso appear to be an attempt to limit the teaching value to the artisan under 35 USC §§ 102 or 103 of this reference. Additionally, we note that appellants' position at pages 4 and 5 of the Brief that appellants' own disclosed invention indicates that the capsule wall is not damaged during the process of the invention is not pertinent to the recitation of any limitation of representative independent claim 1 on appeal.

When considered as a whole, the process of preparing of this claim only prepares a film as the end result of the process recited. There is no statement in the body of this claim that any microencapsulated flakes or powders are prepared by the specific recitations of the methodology recited in this claim in contrast to the desirable end result set forth in the preamble of claim 1. Therefore, arguments directed to this preparation of flakes or powders in the Brief are not pertinent to the actual recitation of subject matter in claim 1. As such, the membrane or film prepared according to the teachings of Cabasso clearly meets the preparation by drying of the "thin-layer" at the end of claim 1 on appeal.

As to appellants' position set forth in the latter half of page 5 of the Brief, we observe that the examiner has not rejected appellants disclosed process. Therefore, appellants' assertion that the examiner is incorrect in asserting any interchangeability of various compounds from Cabasso to appellants' disclosed process is misplaced. It is also not helpful for appellants to argue that Cabasso fails to recognize that certain water-soluble film forming components used in appellants' disclosed process have a flocculation point between 20 and 98°C or be adjustable to within that range.

Since for art rejection purposes, appellants at page 2 of the brief have grouped all claims as standing or falling with claim 1, which is the only claim argued, claims 2 to 8 and 11 to 14 fall with claim 1 on appeal. Note In re Nielson, 816 F.2d 1567, 1570, 2 USPQ2d 1525, 1526-27 (Fed. Cir. 19887); In re Kaslow, 707 F.2d 1366, 1376, 217 USPQ 1089, 1096-97 (Fed. Cir. 1983); and In re Wiseman, 596 F.2d 1019, 1021-22, 201 USPQ 658, 660 (CCPA 1979).

In view of the foregoing, the decision of the examiner rejecting claims 2 and 3 under the second paragraph of 35 USC § 112 is reversed. However, we have sustained the separate rejections of claims 1 to 8 and 11 to 14 under both 35 USC §§ 102 and 103. Accordingly, the decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

JAMES D. THOMAS
Administrative Patent Judge)
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) BOARD OF PATENT
KENNETH W. HAIRSTON)
Administrative Patent Judge) APPEALS AND
)
) INTERFERENCES
)
RAYMOND F. CARDILLO, JR.)
Administrative Patent Judge)

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Marion D. Ford
Patent Department
Wacker Silicones Corporation
3001 Sutton Road
Adrian, Michigan 49221-9397